

REMARKS

Reconsideration and further examination of this application is respectfully requested.

Claims 1-14 have been amended to clarify the limitations of the claims, address antecedent basis between dependent and independent claims, address issues regarding 35 U.S.C. 101, and/or to address issues regarding 35 U.S.C. 112, second paragraph. Therefore, Applicants submit claims 1-14 for further examination.

Applicants noticed that the first name for inventor Mohamad El-Batal appears to be misspelled in the Patent Office records as reflected on the cover sheet of the subject Office Action and in the PAIR database. The Patent Office has spelled the name “Mohammad” with 2 m’s in the middle of the name whereas the correct spelling is “Mohamad” with 1 m in the middle of the name. Applicants have checked the patent application submittal records and the name was spelled correctly on the original application submittal. Applicants respectfully request that the Examiner correct the Patent Office records to reflect the proper spelling of inventor Mohamad El-Batal’s first name.

Independent claims 1, 7 and 12 have been amended to clarify the claim limitations and to address 35 U.S.C. 101 and/or 35 U.S.C. 112, second paragraph, issues. There were extensive amendments to the limitations so Applicants have deleted the original limitations and replaced them with new limitations. For claims 1 and 7, the new limitations are based on the original limitations of the claims, but, in order to keep the text in a more readable format, Applicants chose to replace the limitations in whole. For claim 12, the means limitations were adjusted to more closely correlate with claim 1. For claims 7 and 12, the claims were amended to clarify that the subject of the claims was a “computer network communications system” and not just a “network.” Additional amendments further clarified that the computer network communications system physically includes a network communications medium and active/spare devices. Each of claims 1, 7 and 12 were also amended to clarify that the total number of devices for the computer network communications system exceeds the maximum number of network addresses of the network protocol of the computer network communications system. Support for these amendments may be found in the original claims and throughout the original specification.

Dependent claims 2-6, 8-11, 13 and 14 have been amended to ensure proper antecedent basis with amended independent parent claims 1, 7 and 12. For dependent claims 3, 5 and 6, the

amendments also addressed 35 U.S.C. 112, second paragraph, issues asserted by the Examiner in the subject Office Action.

No new matter has been added by the above described amendments.

In the subject Office Action, the Examiner rejected claims 7-14 under 35 U.S.C. 101 because the Examiner asserted that “the claimed invention is directed to a network and that as such it fails to be any of the categories of patentable subject matter.” Independent claims 7 and 12 have been amended to be directed to a “computer network communications system” that includes the physical structure of a network communications medium as well as active/spare devices. Generally, “If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product.” *Final Computer Related Examination Patent Guidelines*, § IV.B.2.a, *see, e.g.*, *In re Lowry*, 32 F.3d 1579, 1583, 32 USPQ2d 1031, 1034-35 (Fed. Cir. 1994), *In re Warmerdam*, 33 F.3d 1354, 1361-62, 31 USPQ2d 1754, 1760 (Fed. Cir. 1994). As amended claims 7 and 12 are directed to a computer network communications system physically defined by a network communications medium and active/spare devices. Thus, as amended claims 7 and 12 are directed to statutory subject matter under 35 U.S.C. 101. Dependent claims 8-11, 13 and 14 depend from independent claims 7 and 12. Therefore, dependent claims 8-11, 13 and 14 are also directed to statutory subject matter under 35 U.S.C. 101 for the same reasons as independent parent claims 7 and 12.

In the subject Office Action, the Examiner rejected claims 1, 3, 5-7 and 12 under 35 U.S.C. 112, second paragraph, “for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” For claim 7, the Examiner asserted that it was unclear how the spare device was able to obtain an unallocated network address when the active devices used all of the available network addresses. Applicants have amended claim 7 to clarify that the spare device does not determine the unallocated network address until at least one of the active devices is disconnected from the network communications medium. The Examiner further asserted that the meaning of the device means of claim 12 was unclear. Applicants have removed the original means limitations of claim 12 and included means limitations more closely aligned with claim 1. For claims 1, 3, 5-7 and 12, the Examiner also asserted that there were limitations without proper antecedent basis. Applicants have amended claims 1-14, including the claims referenced by the Examiner, to address antecedent basis and Applicants believe the

amendments address the concerns of the Examiner. Thus, as amended claims 1, 3, 5-7 and 12 do not fail under 35 U.S.C. 112, second paragraph.

In the subject Office Action, the Examiner rejected claims 1 and 2 under 35 U.S.C. 103(a) as being unpatentable over Swales (USPN 6,982,953) in view of Wang et al. (USPN 6,470,382) (hereinafter Wang). The Examiner further rejected claims 3-8 and 10-14 under 35 U.S.C. 103(a) as being unpatentable over Swales in view of Wang and further in view of Hanan et al. (USPN 6,792,486) (hereinafter Hanan). The Examiner further rejected claim 9 under 35 U.S.C. 103(a) as being unpatentable over Swales in view of Wang further in view of Hanan and further in view of Corrington et al. (USPN 6,076,142) (hereinafter Corrington).

In the rejection for claim 1, the Examiner asserted that “Swales does not explicitly teach a maximum amount of addresses and devices, as claimed.” However, the Examiner asserted that the disclosure of Wang at column 6, lines 60-65 teaches a maximum amount of network addresses and devices. Column 6, lines 60-65 of Wang state: “For example, the present invention theoretically can dynamically address, manage, and access a quantity of SCSI devices limited only by the quantity of unique addresses available in the 32 bit IP address, the 48 bit MAC address, or the SCSI address limitation in combination with the virtual bus limitation.” *Emphasis added.* Thus, the disclosure of Wang teaches that there is a limited quantity of network addresses, but the disclosure of Wang also teaches that the number of SCSI devices of the Wang system is limited to a maximum number equal to the quantity of unique addresses available.

As amended claim 1 of the subject patent application recites: “providing at least one spare device such that said at least one spare device plus said plurality of active devices results in a total number of system devices that exceeds said maximum number of network addresses.” *Emphasis added.* Claim 1 clearly recites that the total number of devices exceeds the maximum number of network addresses. Wang discloses a system where the number of devices is limited to the maximum number of unique network addresses. Thus, Wang teaches away from including more devices than the maximum number of unique network addresses. Since Wang teaches away from the limitation recited in claim 1, it is improper to combine Wang with other references, including Swales, Hanan, and Corrington. As asserted by the Examiner, Swales does not disclose a maximum amount of addresses and devices. Hanan is directed to switches attached to drives for connection to first, second, and third elements. Corrington is directed a

system that permits a controller to reset the system. Thus, Swales, Hanan, and Corrington do not make up for the deficiencies of Wang. Therefore, the Examiner has failed to make a proper *prima facie* rejection of claim 1 under 35 U.S.C. 103(a) and as amended claim 1 does not fail under 35 U.S.C. 103(a).

As amended independent claims 7 and 12 have similar limitations to claim 1. Thus, the rejections of claims 7 and 12 under 35 U.S.C. 103(a) are also improper for the same reasons as set forth for claim 1. Claims 2-6, 8-11, 13 and 14 are dependent claims depending from independent parent claims 1, 7, or 12. Therefore, dependent claims 2-6, 8-11, 13 and 14 are also not rendered obvious under 35 U.S.C. 103(a) since the independent parent claims 1, 7 and 12 are not rendered obvious by the prior art.

For these reasons, claims 1-14 are proper and are considered to be patentable over the prior art. Therefore, this application is now considered to be in condition for allowance and such action is earnestly solicited.

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